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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,401	12/12/2000	Eckhard Alt	IFD/046	4641

490 7590 06/10/2003

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 06/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/735,401

Applicant(s)
Alt

Examiner
Michael Thaler

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3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61, 64, 65, and 68-84 is/are pending in the application.
- 4a) Of the above, claim(s) 83 and 84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61, 64, 65, and 68-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2003 has been entered.

The disclosure is objected to because of the following informalities: In claim 65, line 2, a comma should be inserted after "wall". Appropriate correction is required.

Newly submitted claims 83 and 84 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions I (claims 61, 64, 65, 68) and II (claims 83 and 84) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make another and materially different product. For example, it could be used to make a stent wherein the struts do not completely bound the holes as defined in claim 61, line 4 and claim 65, line 4-5.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 83 and 84 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 61, 64, 65 and 68-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontaine (5,370,683) in view of Alfidi et al. (3,868,956). Fontaine, in figures 10-12, shows a stent having a wall with a multiplicity of holes formed therethrough, the tubular wall defined by a plurality of struts. Fontaine shows the cross-section of the struts as circular rather than oval. However, Alfidi et al. teach that the cross-section of stent struts may be oval (figure 13D) rather than circular (figure 13 C) in order to maximize the area of contact between the stent and the wall of the vessel (col. 8, lines 13-18). It would have been obvious to make the cross-section of the Fontaine struts oval rather than circular so that it too would have this advantage. The language "the holes having been formed by removal of material from the wall" in claim 61, line 3 involves a product by process limitation. However, the determination of patentability is based upon the product itself rather than the method of manufacturing the product. The patentability of a product does not depend on its method of production. If the product in the product by process

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claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (M.P.E.P. 2113). In this case, the product in is the same as or obvious from a product of the prior art. As to claims 71 and 78, Fontaine shows connectors (the welds described in col. 6, lines 22-23). As to claims 72-75 and 79-82, Fontaine fails to disclose the claimed taper. However, it is well known in this art to provide a taper the exterior surface of stents at their ends in order to facilitate smooth passage within a blood vessel. It would have been obvious to include a taper in the Fontaine stent so that it too would have this advantage.

Claims 61, 64, 65 and 68-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (5,593,442) in view of Alfidi et al. (3,868,956). The Klein stent is formed from a single open ended tube (col. 6, lines 10-17). Klein shows the cross-section of the struts as rectangular rather than oval. However, Alfidi et al. teach that the cross-section of stent struts may be oval (figure 13D) rather than rectangular (figure 13 B). The rounded oval shape has the self evident advantage over the rectangular shape of reducing the chance of damaging the blood vessel since there are no sharp edges to so damage it. It would have been obvious to make the cross-section of the Klein struts oval rather than rectangular so that it too would have this advantage. As to claims 71 and 78, Klein shows connectors (e.g. 50

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or 52). As to claims 72-75 and 79-82, Klein fails to disclose the claimed taper. However, it is well known in this art to provide a taper in stents in order to have the advantage of closely conforming the shape of the exterior surface of the stent to a varying diameter of a blood vessel. It would have been obvious to include a taper in the Klein stent so that it too would have this advantage.

Claims 61, 64, 65, 68-70, 76 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Alfidi et al. (3,868,956). Alfidi et al. in figures 11, 12 and 13D, show a scaffold formed from a single open ended tube (the appliance 90 is considered to be a tube since it is generally tubular) having a multiplicity of through-holes (the open spaces between the windings of the coil and the straight segment of the wire which extends along the longitudinal axis of the tube) and struts (the windings of the coil and the straight segment of the wire) which completely bound the holes. As to claims 64 and 68, the Alfidi et al. windings of the coil have a serpentine or winding configuration as broadly claimed.

Applicant's arguments filed April 30, 2003 have been fully considered but they are not persuasive for the reasons set forth above. Also, the allegation that the Alfidi et al. through-holes are not bounded completely by the struts is incorrect. Each Alfidi et al. through-hole has a shape of a segment (one winding) of a helix. Each through-hole is bounded on the sides by the windings

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of the coiled wire and on the ends by the straight segment of the wire. Each through-hole is thus bounded completely by the struts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
June 9, 2003


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731